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08/853,323	05/08/97	TALIEH	H

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EXAMINER	
NGUYEN, G	
ART UNIT	PAPER NUMBER
3723	8

DATE MAILED: 08/05/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

# Office Action Summary

Application No.

08/853,323

Applicant(s)

Talieh et al.

Examiner

Nguyen

Group Art Unit

3723



☒ Responsive to communication(s) filed on Jun 2, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 23-32, 34, and 36-43 is/are pending in the application.

Of the above, claim(s) 23-31 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 32, 34, and 36-43 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

Please note this action is not final due to a new ground of rejection.

#### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 23-29, drawn to an CMP with a linear moving polishing belt having a conditioning means, classified in class 451, subclass 21.
  - II. Claims 30-31, drawn to a wafer holder, classified in class 451, subclass 397.
  - III. Claims 32, 34, and 36-43, drawn to a polishing belt assembly having a laminated belt structure, classified in class 451, subclass 307.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions I, II, and III have different functions as claimed.
3. Because these inventions are distinct for the reasons given above and the search required for each group is unrelated, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. William Webb on July 29, 1998 a provisional election was made with traverse to prosecute the invention of Group III, claims 32, 34, and 36-

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43. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 23-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Allowable Subject Matter***

6. The indicated allowability of claims 33 and 35 in Paper No.5 is withdrawn in view of the newly discovered reference(s) to Sampietro'309. Rejections based on the newly cited reference(s) follow. Therefore, this action is not final.

***Claim Rejections - 35 USC § 112***

7. Claims 32, 34, 36, 37, 38, and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The recitation that “for polishing a semiconductor wafer” has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 32, 34, and 36-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sampietro’309 in view of McGarvey’765.

Sampietro discloses an abrasive tool comprising an abrasive containing layer and a fabric backing layer adapted to be fastened to a plate on the machine. The term “tool” is used to describe all forms of releasably attached discs, belts or trips. With reference to Fig. 2, the polishing pad includes a flexible support (3) and a coating of an abrasive material (4). Adhered to the other side of the flexible support (3) is a layer (5) of a resilient material such as polyurethane,

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EPDM polymer. Other hard wares necessary to run the belt is well-known in the art. But Sampietro does not disclose the belt being formed of metal.

McGarvey discloses an abrasive belt. With reference to column 2, lines 12-22, McGarvey discloses that the backing material (1) may be glue, resin, or varnish, the choice of which depends on the desired flexibility and stretch, resistance to heat and other factors which are determined by the intended use of the finished article and production requirements.

Sampietro discloses the claimed invention except for the belt being formed of metal. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the belt being formed of metal since it was known in the art as taught by McGarvey that the choice of the backing material would depends on the desired flexibility, resistance to heat and other factors which are determined by the intended use of the finished article and production requirements.

### *Response to Arguments*

10. Applicant's arguments with respect to claims 32, 34, and 36-41 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gorsuch et al.'609 and Hibbard et al.'844 all disclose abrasive belt with flexible backing material.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nguyen whose telephone number is (703) 308-0163. The examiner can normally be reached on Monday-Friday from 7:00 AM-3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Scherbel, can be reached at (703) 308-1272. The fax number for this Group is (703) 305-3579.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 308-1148.

George Nguyen

7/30/98

**ROBERT A. ROSE**  
**PRIMARY EXAMINER**  
**ART UNIT 323**

